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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/945,705 02/23/97 YAMADA

M JP6-131165

EXAMINER

IM12/0604

EXXON RESEARCH AND ENGINEERING COMPANY
P O BOX 390
FLORHAM PARK NJ 07932-0390

MEDLEY, M

ART UNIT

PAPER NUMBER

1721

DATE MAILED:

06/04/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-5 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-5 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit: 1721

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Art Unit: 1721

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

Art Unit: 1721

U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al 5,281,347 in view of Umemura et al 4,692,256, Rowman et al 4,360,438, Papay et al 4,178,258, Ward, Jr., 4,846,983, Farmer et al 3,509,051, Le Suer 3,254,025 and White et al 4,330,420.

Applicants claim a lubricating oil composition comprising a lubricating base oil and additives consisting essentially of (a) sulfoxymolybdenum dithiocarbamate, (b) zinc dialkyldithiophosphate and (c) a mixture of calcium and magnesium alkylsalicylate and claim 2 (and its dependent claims) additive further consisting essentially of (d) succinimide containing boron.

Igarashi et al disclose a lubricant oil composition comprising (a) and optionally provides for the inclusion of (b), (c) and (d) without explicit teachings to its being boronated (column 3, lines 25 to column 4, lines 1-25).

Art Unit: 1721

However, Le Suer discloses boron containing succinimides as useful additives in lubricant compositions (column 2, lines 6-40 and column 21, lines 73 to column 22, lines 1-64). Further, Umemura et al (column 4, lines 3-end and column 5, lines 5-end; Rowman et al (column 1, lines 40-66 and column 3, lines 1-24), Papay et al (see in the entirety), Wards, Jr. (column 2, lines 37 to column 3, lines 1-20 and Tables I and II) and Farmers et al (abstract and column 1, lines 28-62 and claims) teach Igarashi et al additives in a lubricating oil composition and provides for the inclusion and addition of Le Suer boron containing additives. White et al disclose a fully formulated lubricant composition comprising the claimed (b) zinc dialkyldithiophosphate 0.05% (see Tables I to III, column 2, lines 4-22).

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have added the boron containing succinimide additive of the secondary references to Igarashi et al composition, because combining two or more materials disclosed by the prior art for

Art Unit: 1721

the same purpose to form a third material that is to be used for the same purpose has been held to be a prima facie case of obviousness, See In Kerkhoven, 205 USPQ 1069. Further the claims contain the open-ended language “comprising” which would not exclude the additives of the secondary references.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 (and its dependent claims) and 2 (and its dependent claims) are indefinite for “(c) a mixture of 100 to 50%... and 0 to 50%... alkylsalicylate” because it is unclear when the upper limit is of 100% and the lower limit is of 0% that a mixture exist. Claims 1 and 2 (and their dependent claims) are further indefinite for failing to disclose the relative proportion of each component of the lubricant composition.

Art Unit: 1721

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art is pertinent to show the state of the art knowledge at the time of the claimed invention.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 6:00 P.M. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharon Gibson, can be reached on (703) 308-4552. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

M. Medley:jp

June 2, 1998/June 4, 1998


MARGARET MEDLEY
PRIMARY EXAMINER
GROUP 110 1721